



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,782	08/08/2006	Roger Bassett	37801-66480	6300

30567 7590 12/01/2010

Levenfeld Pearlstein, LLC
Intellectual Property Department
2 North LaSalle
Suite 1300
Chicago, IL 60602

EXAMINER

JOHNSON, AMY COHEN

ART UNIT	PAPER NUMBER
----------	--------------

2841

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

MJWDOCKET@LPLEGAL.COM
MEFDOCKET@LPLEGAL.COM

Office Action Summary	Application No. 10/597,782	Applicant(s) BASSETT, ROGER	
	Examiner Amy Cohen Johnson	Art Unit 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-42, 44-50, 52-58 and 67-70 is/are rejected.
- 7) ☒ Claim(s) 43, 51 and 59-66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 36 rejected under 35 U.S.C. 103(a) as being unpatentable over Bassett (U. S. Patent No. 6,422,102).

Bassett discloses a cutting tool adjustment system comprising a body (40) for adjustably holding a metal cutting tool (42), a metal cutting tool (42) held in the body, adjustment means (19) mechanically engageable with the body for positionally adjusting a cutting edge of the cutting tool (Figs. 2, 3, 6, Col 5, line 3-Col 6, line 8, wherein the adjustment means is self-contained in housing body 26 with lid 24), and a means electronically engageable with the body and including a power supply means for at least powering means providing information as to adjustment made, in use, to said cutting edge position by said adjustment means (Col 5, line 59-Col 6, line 8, Col 6, line 17-Col 7, line 19, wherein means electronically engageable with the body include the Hall sensors 52, 53 and the heating element of the adjustment system which are electronically engageable with the power supply of the body, control electronics are housed within the body and are electronically engageable with adjustment means 19, current is supplied to the clamp actuator 36, further positioning loops 62a,62b are electronically engaged between the body and the adjustment means, means for providing information as to adjustment made are

Art Unit: 2841

provided to control electronics 44, controller 48 and microcontroller 60 through sensors 52, 53 and the battery in the body).

Bassett discloses the system wherein the means for providing information as to the adjustment made to the cutting tool edge position is a visual display (48b); wherein the visual display is an electronic display (48b, Col 6, lines 21-25); wherein the visual display is part of the means electronically engageable with the body (since 48b is part of the entire system, it is considered to be part of the means electronically engageable with the body, Examiner notes that this claim is not directed to a specific structural relationship between the visual display and the means electronically engageable with the body, further it is noted that the visual display is housed in a device (hand-held controller 48) which is part of the adjustment system which is electronically releasable engageable with the body); wherein the visual display shows a pre-programmed amount of adjustment (Col 6, lines 17-55, wherein the adjustment is pre-programmed by the user inputting the desired adjustment); wherein the visual display is an LCD (48b, Col 6, lines 21-25); wherein the visual display is part of a display module (48), spaced from the adjustment means and the means engageable with the body, and incorporating a receiver (Col 6, lines 3-8, lines 52-55) for a signal transmitted from the body or the means engageable therewith; wherein the display module is a hand-held, battery powered device (48); wherein the adjustment means is fitted to the means electronically engageable with the body to define an adjuster tool (Col 5, lines 3-58); wherein when the adjuster tool is engaged with the body, there is at least one electrical contact therebetween (Col 5, line 59-Col 6, line 8); wherein the body is a cartridge (40); wherein the body is a bush unit (the body can be considered a bush

Art Unit: 2841

unit since there are no structural limitations claimed which define the term “bush unit”); wherein the cartridge is mountable on a boring bar (40).

Bassett does not disclose a cutting tool adjustment system wherein the adjustment means is mechanically releasably engageable with the body, wherein the electronic means is electronically releasably engageable with the body.

However, the term “releasably” does not structurally distinguish the claimed invention from Bassett, since, in a broad sense, any structure may be considered to be “releasably”, if so desired as long as the structure may be removed by any means, if so desired. See MPEP 2144.04C and *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) wherein the court held that if it were considered desirable for any reason to have a part be removable, then it would have been obvious to make it removable for that purpose. In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the adjustment means mechanically releasably engageable with the body and the electronic means electronically releasably engageable with the body in order to provide a means for facilitating a repair or replacement of the parts contained within the adjustment means housing of Bassett.

With respect to claims 40 and 46: Bassett discloses an electronic display providing data. The use of the particular type of display claimed by applicant, i.e., providing visual display as the adjustment means is operated or providing a scale with an increasing or decreasing bar, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the data is visually displayed to a user, as already suggested by Bassett, 2) the type of display claimed by

Art Unit: 2841

Applicant and the type of display used by Bassett are well known alternate types of visually providing data which will perform the same function, if one is replaced with the other, of providing a user with a visual display of data, and 3) the use of the particular type of display by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of displays that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to provide a visual display of data as already suggested by Bassett. See MPEP 2144.06 and MPEP 2144.07. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data displayed as the adjustment means is operated in order to provide a “real-time” display to a user, allowing the user to have constant monitoring of the adjustment means and in order to have the data displayed as a scale with an increasing or decreasing bar in order to provide a clear visual display to a user of the data and so that a user could quickly determine if a measurement was increasing or decreasing without needing to interpret numerical information.

With respect to claim 42: Basset discloses an adjustment means wherein the pre-programmed amount of adjustment is effected automatically upon engagement of the electrically engageable means with the body (Col 7, lines 24-33) and Bassett discloses a means for driving the adjustment means. The use of the particular type of driving means claimed by applicant, i.e., motor driving means, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the cutting edge is positionally adjusted, as already suggested by Bassett, 2) the driving means claimed by Applicant and the driving means used by Bassett are well known

Art Unit: 2841

alternate types of driving adjustment means for positioning which will perform the same function, if one is replaced with the other, of adjustably positioning the cutting edge, and 3) the use of the particular type of driving means by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of driving means that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to adjustably position the cutting edge as already suggested by Bassett. See MPEP 2144.06 and MPEP 2144.07. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the adjustment means be motor driven as a motor driven adjustment is an alternate form of providing an adjustment which provides the same function of adjusting the cutting edge of the cutting tool.

Regarding claims 53-58: Bassett discloses a system wherein the system includes a power supply means; wherein the power supply means is provided by a battery (Col 5, lines 66-67); wherein the body contains electronic circuitry which generates a signal voltage dependent upon the amount of adjustment of the cutting tool edge (Col 6, lines 17-55, Col 6, line 63-Col 7, line 33); wherein the relationship between the amount of adjustment of the cutting tool edge and the signal voltage generated is non-linear (Col 6, lines 9-16); wherein said electronic circuitry regulates and applies an output from an electronic position sensor monitoring the position of said cutting tool edge (Col 6, lines 17-55, Col 6, line 63-Col 7, line 33).

Bassett does not disclose the system wherein the power supply means is provided in the adjuster tool; wherein the battery is rechargeable.

Regarding claim 53: Bassett discloses the adjustment system wherein the battery is provided in the body. Changing the location of the battery from the location shown by Bassett to

Art Unit: 2841

a location on adjuster tool, absent any criticality, is only considered to be an obvious modification of Bassett device that a person having ordinary skill in the art at the time the invention was made would be able to provide using routine experimentation since the courts have held that there is no invention in shifting the position if the operation of the device would not be thereby modified. See *In re Japikse*, 86 USPQ 70 (CCPA 1950) and MPEP 2144.04 VI. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the battery be in the adjuster tool of Bassett since the position of the battery from the body to the adjuster tool would not affect or modify the operation of the device of providing power to the adjuster tool.

With respect to claim 54: Bassett discloses the system with a battery. The use of the particular type of power supply claimed by applicant, i.e., rechargeable battery, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the data is displayed on a powered display device as already suggested by Bassett, 2) the power supply claimed by Applicant and the power supply used by Bassett are well known alternate types of power supplies which will perform the same function, if one is replaced with the other, of powering a display device, and 3) the use of the particular type of power supply by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of power supplies that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to power a display device, as already suggested by Bassett. See MPEP 2144.06 and MPEP 2144.07. Therefore, it would have been obvious to one

Art Unit: 2841

of ordinary skill in the art at the time the invention was made to have the power supply be a rechargeable battery in order to provide a power supply which does not require replacing batteries.

Regarding claim 70, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). See MPEP 2106 and 2111.04. In this case the intended use is considered to be “mountable on a reaming tool” since this is a recitation with respect to the manner in which the body is intended to be employed and does not structurally differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations of a body. It is noted that there are no structural limitations claimed for the terms cartridge and bush unit and how they would be used, for a boring bar or for a reaming tool, therefore, these limitations are considered to be intended use of the apparatus. Furthermore, there is no structural limitation regarding a mounting means, therefore, it is unclear as to how the cartridge would be mountable on a boring bar or a reaming tool, and as such, this is considered to be intended use of the device.

3. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bassett in view of Struble (U. S. Patent No. 5,657,550).

Bassett discloses the system as described above in paragraph 2.

Bassett does not disclose the system wherein the means for providing information as to the adjustment made to the cutting edge position is a simulated voice output.

Art Unit: 2841

Struble discloses a device wherein at least one LED (174) turns on or off to indicate when said pre-programmed amount has been measured (Col 10, lines 40-54, Col 18, lines 1-11); wherein the means for providing information is a simulated voice output (Col 30, lines 44-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a simulated voice output in the system of Bassett, as taught by Struble, so that a user would have a clear indication of a pre-programmed amount without the need to interpret numerical data.

Allowable Subject Matter

4. Claims 43, 51, 59-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments with respect to claims 36-70 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Haimer (US PG PUB 2009/0214303), Tarris et al. (U. S. Patent No. 6,434,852), Muendlein et al. (U. S. Patent No. 5,251,511), York (U. S. Patent No. 5,000,627).

Art Unit: 2841

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Cohen Johnson whose telephone number is (571)272-2238.

The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on (571) 272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amy Cohen Johnson/
Primary Examiner, Art Unit 2841

ACJ
November 22, 2010